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Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Synthes (U.S.A.)
v.
Cypress Medical Products, L.P.

Opposition No. 91123720
Cancellation No. 92031730

Nancy Zoubek of Jones Day for Synthes (U.S.A.).¹

Jeffrey A. Pine of Baniak Pine & Gannon for Cypress Medical
Products, L.P.

Before Hairston, Chapman and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

INTRODUCTION

The above-captioned opposition and cancellation
proceedings were consolidated by order of the Board dated

¹ The Board has ascertained that, subsequent to the completion of the briefing of these cases, opposer/petitioner's counsel, Ms. Zoubek, moved to a new firm, i.e., Jones Day. (She was with Pennie & Edmonds during litigation of these proceedings.) Although no written notification of the change of address was filed, to expedite matters the Board has updated its records for opposer/petitioner's correspondence address as follows: Nancy

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September 30, 2002. Synthes (U.S.A.) is the opposer and petitioner in the respective cases, and in this decision we shall refer to it as opposer/petitioner or as plaintiff. Cypress Medical Products, L.P. is the applicant and the respondent in the respective proceedings, and in this decision we shall refer to it as applicant/respondent or as defendant. Because the opposition and the cancellation involve the same parties and common questions of law and fact, we shall decide them both in this single opinion, which shall be entered in both proceeding files.

In the application involved in the opposition proceeding, defendant seeks registration on the Principal Register of the mark SYNTHESIS PF (in typed form) for Class 10 goods identified in the application as "disposable gloves for medical use."² Defendant's registration, involved in the cancellation proceeding, is of the mark SYNTHESIS (in typed form), and is likewise for "disposable gloves for medical use."³

Zoubek, Jones Day, 222 East 41st St., New York NY 10017-6702. Applicant's counsel should do likewise.

² Application Serial No. 75909304, filed February 3, 2000. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), and January 5, 1998 is alleged in the application as the date of first use of the mark anywhere and the date of first use of the mark in commerce. Defendant has disclaimed the exclusive right to use PF apart from the mark as shown; the evidence shows that PF stands for "powder free." (Sabatka Depo. at 12, 26.)

³ Registration No. 2371569, which issued on July 25, 2000 from an application filed on May 20, 1998. In the registration, December

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On January 25, 2001, plaintiff filed a notice of opposition to defendant's pending application and a separate petition to cancel defendant's registration, asserting in both cases a Section 2(d) claim of priority and likelihood of confusion as its ground for opposition and cancellation, respectively. Trademark Act Section 2(d), 15 U.S.C. §1052(d).⁴ Specifically, plaintiff alleged that it is the prior user of the trade name and trademark SYNTHES on or in connection with instruments and apparatus for surgical, medical and veterinary purposes; that it is the owner of Registration No. 999397, which is of the mark SYNTHES (in typed form) for Class 10 goods identified in the registration as "instruments and apparatus for surgical, medical, and veterinary purposes solely for bone surgery, namely, instruments and implants for osteosynthesis, including bone screws, bone nails, bone plates and splints;

18, 1997 is alleged as the date of first use of the mark anywhere and the date of first use of the mark in commerce.

⁴ In both cases, plaintiff also pleaded a claim of dilution under Trademark Act Section 43(c), 15 U.S.C. §1125(c). However, plaintiff presented no argument in support of a dilution claim in either its main brief or its reply brief, and we therefore deem plaintiff to have waived this pleaded ground in both cases. Additionally, in the "Statement of the Issues" sections of its main briefs in the opposition and cancellation proceedings, plaintiff states that an issue to be determined is whether defendant's marks falsely suggest a connection with plaintiff. Because no such Section 2(a) ground (15 U.S.C. §1052(a)) was pleaded or tried, and because plaintiff's briefs include no further argument as to such ground in any event, we have given this issue no consideration.

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injection needles, and gum plates";⁵ and that each of defendant's marks, as applied to the goods identified in defendant's application and registration, so resembles plaintiff's trade name and trademark SYNTHES as to be likely to cause confusion, to cause mistake or to deceive.

Defendant answered the notice of opposition and the petition for cancellation by denying the salient allegations thereof.⁶

At trial, plaintiff submitted the testimony depositions of its officers Stephen Schwartz (Senior Vice-President) and Michele Zaborowski (Comptroller) and the exhibits thereto; the testimony deposition (under subpoena) of Thresa Waite (defendant's Director of Marketing) and the exhibits thereto; and, under Notice of Reliance, a status and title copy of its pleaded Registration No. 999397, and copies of the file histories for registrations of various other marks which are owned by defendant. For its part, defendant submitted the testimony deposition of Timothy Sabatka (its

⁵ Issued December 10, 1974. Affidavits under Sections 8 and 15 accepted and acknowledged. Renewed for ten years from December 10, 1994.

⁶ Defendant also pleaded various "affirmative defenses." Two of them (i.e., that there is no likelihood of confusion, and that there is no dilution) are not properly deemed defenses but rather are mere further denials of plaintiff's pleaded claims. Defendant's "failure to state a claim" defense is without merit, inasmuch as plaintiff's pleadings in fact state claims for relief. Defendant's pleaded defenses of laches, estoppel, acquiescence and waiver are not supported by the evidence of record. Defendant's allegation that plaintiff is not the owner of its pleaded mark is likewise not borne out by the record.

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Chief Financial Officer and Chief Operating Officer) and the exhibits thereto (including printouts of third-party registrations and applications from the USPTO's electronic database).

The consolidated opposition and cancellation have been fully briefed, but no oral hearing was requested.

PAPERS IMPROPERLY FILED UNDER SEAL; REDACTED COPIES DUE IN 30 DAYS

A preliminary issue with respect to the record herein requires discussion. Trademark Rule 2.27(e), 37 C.F.R. §2.27(e), provides that "when possible, only confidential portions of filings with the Board shall be filed under seal." A similar provision also appears in the parties' own protective agreement, and the Board expressly reminded the parties of this requirement in its order entering that protective agreement. Despite this requirement, the parties submitted the above-referenced testimony depositions (with exhibits), as well as their briefs, entirely under seal. Such submission of entire filings under seal, including obviously non-confidential portions thereof, is improper. The Board telephoned counsel for each party and required them to resubmit their filings in compliance with Trademark Rule 2.27(e), i.e., with only the confidential portions thereof filed under seal.

In response, applicant's counsel has submitted a properly-redacted copy of the testimony deposition of Timothy Sabatka (and exhibits thereto). However, applicant has not submitted a redacted copy of its brief, and opposer has failed to resubmit any of its filings. To avoid further delay in issuance of a final decision in these cases, the Board, in preparing this opinion, has used its best judgment as to what information in the parties' papers can reasonably be deemed to be confidential, and has refrained from relating such confidential information in the opinion.

However, the parties are allowed until **thirty days** from the date of this decision to submit properly redacted copies of their filings, with only the confidential portions thereof filed under seal. Such filings may be made electronically via ESTTA, or may be made on paper or on CD-ROM in accordance with Trademark Rule 2.126. *See generally* TBMP §106.03 (2d ed. rev. 2004). If no such redacted copies are filed within the time allotted, the filings which currently are improperly filed entirely under seal shall be unsealed and entered into the public record of these proceedings. *See* Trademark Rule 2.27(a); TBMP §106.03.

DEFENDANT'S MOTION TO STRIKE

As an exhibit to its reply brief, plaintiff submitted (for the first time) a copy of an assignment document,

executed and recorded in 1984, which effects the assignment of its pleaded Registration No. 999397, *inter alia*, from Synthes AG, a Swiss corporation and the original owner of the registration, to Synthes Ltd. (U.S.A.), apparently another predecessor in title to plaintiff. Applicant filed a motion to strike this evidence on the ground that it is untimely, and plaintiff has contested the motion. In an interlocutory order, the Board deferred consideration of the motion until final decision.

We grant defendant's motion to strike. The evidence attached to plaintiff's reply brief was not made of record during trial, and it therefore cannot be made of record by attachment to plaintiff's brief. See TBMP §704.05(b) (2d ed. rev. 2004), and cases cited therein.⁷

STANDING

Turning now to the merits of the case, plaintiff has made of record a status and title copy of its pleaded Registration No. 999397 which shows that the registration is extant and is owned by plaintiff. In view thereof, and

⁷ We note, however, that this 1984 assignment document essentially is irrelevant to this case. As discussed *infra*, plaintiff has made of record a status and title copy (issued in 2002) of the pleaded registration which shows that the registration currently is extant and is owned by plaintiff, presumably by virtue of an assignment or assignments which occurred after 1984. The 1984 document showing a prior link in the chain of title is neither necessary to plaintiff's claim of

because plaintiff's likelihood of confusion claim is non-frivolous, we find that plaintiff has established its standing to bring these proceedings. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

SECTION 2(d) GROUND: PRIORITY

For purposes of the opposition proceeding, priority is not at issue with respect to the goods identified in plaintiff's pleaded registration, i.e., "instruments and apparatus for surgical, medical, and veterinary purposes solely for bone surgery, namely, instruments and implants for osteosynthesis, including bone screws, bone nails, bone plates and splints; injection needles, and gum plates." *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In any event, as to both the opposition and the cancellation proceedings, petitioner has proven that it has used SYNTHES in commerce since 1975, both as a trade name and as a trademark on the goods identified in its registration and on various accessory and ancillary goods (such as storage cabinets and trays, power tools used for bone surgery, etc.).⁸ Such use

current ownership of the registration, nor (contrary to defendant's contention) does it rebut that claim of ownership.

⁸ Defendant contends that plaintiff's evidence shows use of the mark on catalogs only, and fails to show affixation of the mark to the goods themselves. Defendant argues that plaintiff's use

predates defendant's application filing dates and its alleged dates of first use. We therefore find that to the extent that priority is at issue in these cases, plaintiff has established such priority for purposes of both the opposition proceeding and the cancellation proceeding.

SECTION 2(d) GROUND: LIKELIHOOD OF CONFUSION

The remaining issue for determination is whether plaintiff has established that defendant's marks, as applied to the goods identified in the involved application and registration, so resembles plaintiff's registered and/or previously-used SYNTHES mark and trade name as to be likely to cause confusion. Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I.*

of the mark on its catalogs might establish service mark use but it does not establish trademark use. We are not persuaded. First, in the absence of any counterclaim for cancellation of plaintiff's pleaded registration, the affixation issue is irrelevant insofar as the goods identified in that registration are concerned. Second, plaintiff's catalogs include photographs of various items, including storage trays for the goods, upon which the mark has been affixed. Third, as plaintiff notes, the manner in which its mark is used in its catalogs constitutes valid technical trademark use, under *Lands End, Inc. v. Manbeck*, 797 F.Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992). Finally, even if we were to assume that the evidence does not establish technical trademark use by plaintiff, we find that it certainly is evidence of prior use analogous to trademark use and prior trade name use, both of which suffice to bar registration of defendant's marks under Section 2(d) (assuming that likelihood of confusion also is proven).

du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We also must bear in mind that the fame of a plaintiff's mark, if it exists, plays a "dominant role in the process of balancing the *DuPont* factors." *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

We make the following findings of fact as to each of the pertinent *du Pont* factors.

Similarity of the Marks

We first must determine whether defendant's marks (SYNTHESIS and SYNTHESIS PF) and plaintiff's mark (SYNTHES), when compared in their entirety in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that

confusion as to the source of the goods offered under the respective marks is likely to result. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Initially, we find that in defendant's mark SYNTHESIS PF, the dominant feature of the mark is the word SYNTHESIS. The letters PF, which stand for the descriptive or generic designation "powder free," contribute relatively little to the commercial impression of the mark, either in terms of appearance, sound or connotation. For this reason, we give more weight to the dominant feature SYNTHESIS and less weight to the letters PF when we compare defendant's mark to plaintiff's mark. Although we do not ignore these letters and instead consider applicant's mark in its entirety, we find that the fact that they appear in defendant's mark but not in plaintiff's mark does not suffice to distinguish the marks in terms of their overall source-indicating commercial impressions. *In re National Data Corp.*, *supra*.

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In terms of appearance, we find that each of defendant's marks is more similar than dissimilar to plaintiff's mark. The marks share the same seven first letters (SYNTHESES). They differ only in that defendant's marks add the letters -IS at the end of SYNTHES, and in that the mark in defendant's pending application includes the descriptive and disclaimed letters PF. We find that these points of dissimilarity are outweighed by the similarity in appearance which arises from the presence of SYNTHES at the start of each of the marks.

In terms of sound, we again find that each of defendant's marks is more similar than dissimilar to plaintiff's mark. The first (and/or only) word in defendant's marks would be pronounced as the word "synthesis." The evidence shows that plaintiff prefers to pronounce its mark as "sinth-aze," but it is settled that there is no "correct" pronunciation of trademarks because the manner in which purchasers will pronounce such marks cannot be predicted with certainty. See, e.g., *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985); and *In re Energy Telecommunications & Electrical Association*, 222 USPQ 350 (TTAB 1983). Indeed, the evidence shows that plaintiff's customers pronounce plaintiff's mark in a variety of ways, such as "sinth-eez" or "sinth-ess" or "sinth-uss." These last two pronunciations, which are

entirely plausible, would be identical to the common pronunciation of the first two syllables of the word "synthesis" in defendant's marks. The final syllable of that word merely adds to the succession of sibilants spoken in the first two syllables, and does little to distinguish the parties' marks aurally. The letters PF in defendant's SYNTHESIS PF mark do not appear and thus would not be vocalized in plaintiff's mark, but that difference does not suffice to distinguish the marks, given the descriptive significance of those letters as applied to defendant's goods. On balance, we find that the marks sound more similar than dissimilar.

In terms of connotation, we find, again, that the marks are more similar than dissimilar. Obviously, defendant's marks connote the word "synthesis," i.e., "the composition or combination of parts or elements so as to form a whole." (Webster's Ninth New Collegiate Dictionary (1990) at 1198.⁹) We find that plaintiff's mark SYNTHES would readily be perceived by purchasers as a truncation or derivative of the same word, i.e., "synthesis." The mark consists of the first seven letters of the word "synthesis," and it has no apparent other meaning. This purchaser perception or

⁹ The Board may take judicial notice of dictionary definitions. See, e.g., *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); see also TBMP §704.12(a) (2d ed. rev. 2004).

understanding is especially likely given the nature of plaintiff's goods, which are identified in plaintiff's registration as "instruments and implants for osteosynthesis."¹⁰ (Emphasis added.) The letters PF in defendant's SYNTHESIS PF mark connote "powder free," a descriptive or generic designation which contributes little or nothing to the mark's source-indicating function. Any dissimilarity in connotation which results from the presence of those letters in defendant's mark and their absence from

¹⁰ We take judicial notice that "osteosynthesis" is defined as "internal fixation of a fracture by means of a mechanical device, such as a pin, screw, or plate." (Stedman's Medical Dictionary (27th ed. 2000) at 1286.) Plaintiff's witness Mr. Schwartz testified (on cross-examination) that the mark SYNTHESIS is derived from the name of a Swiss international foundation called AO/ASIF, with which plaintiff works closely in providing continuing medical education services, and that "AO stands for Arbeitsgemeinschaft fur Osteosynthesefragen." (Schwartz Depo. at 81, 89.) When asked what "Osteosynthesefragen" means, he testified as follows:

A. Fragen is - I believe a Swiss or German word for study. Excuse me, for issues or problems. So Synthesefragen is - osteosynthesefragen is bone healing issues.

Q. Is osteo bone?

A. Yes.

Q. And Synthes is healing?

A. Yes.

(Id. at 90-91. However, our own review of a German-English dictionary reveals that the German word "synthese" means "synthesis" in English, not "healing." (Cassell's German-English English-German Dictionary (1978) at 599.) Of course, in the context of osteosynthesis, the "healing" of a bone fracture could be described as a synthesis, i.e., a "combination of parts or elements so as to form a whole." Regardless of the derivation of plaintiff's mark or its meaning (if any) in German, we find that purchasers in this country are likely to perceive the mark, as applied to goods used in the field of osteosynthesis, as a truncation or derivative of the English word "synthesis."

plaintiff's mark is greatly outweighed by the basic similarity in connotation which arises from the fact that both marks mean, or would be perceived as being derived from, the word "synthesis."

For the reasons discussed above, we find that when the parties' marks are compared in their entireties, they are more similar than dissimilar in terms of their overall commercial impressions. The first *du Pont* factor thus weighs in plaintiff's favor.

Similarity of the Goods, Trade Channels and Purchasers

We turn next to a consideration of the second and third *du Pont* factors, i.e., the similarity or dissimilarity of the parties' goods, the trade channels in which those goods are marketed, and the classes of purchasers to whom they are marketed. We note generally that it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an

association or connection between the sources of the respective goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978).

Plaintiff's goods, as identified in plaintiff's registration, are "instruments and apparatus for surgical, medical, and veterinary purposes solely for bone surgery, namely, instruments and implants for osteosynthesis, including bone screws, bone nails, bone plates and splints; injection needles, and gum plates." Plaintiff's witness Mr. Schwartz testified that plaintiff

...is in the business of what you might call skeletal fixation which is fracture fixation using operative, surgical intervention and different appliances or components or implants to fasten the fracture pieces back together. Synthes is also involved in some reconstructive orthopedic surgery and any type of skeletal fixation that would, basically, go from head to toe from the maxillofacial skeleton to the normal axial skeleton and also including spine surgery.

(Schwartz Depo. at 5-6.) He also testified that

[a]ny hospital that has an active orthopedic or maxillofacial or spine service will use Synthes' products in some way, shape or form. Additionally our products are also used in short stay surgical centers and also in doctors' offices where they would do a day-surgery procedure. It could be something as simple as

going in to have a screw put into your hand for a relatively simple fracture that could be done on the same day basis. Or it could be something as involved as a major spine reconstruction or pelvis reconstruction that would be done at a major acute care facility. The spectrum is very broad and our products are used - kind of across the board in those different types of operating rooms and hospitals.

(Schwartz Depo. at 25.) This testimony as to the nature and range of plaintiff's products is borne out by the exhibits to Mr. Schwartz' testimony, which include catalogs and price lists covering a large variety of bone surgery implants and instruments in a variety of sizes, as well as accessory items such as power tools and storage trays and cases. Plaintiff's goods range from individual screws and plates costing around ten dollars to complete sets of implants and instruments, costing many thousands of dollars, which are used in complex bone surgery procedures. (See, e.g., Schwartz Depo., Exh. Nos. 5, 11.)

As shown by the testimony quoted above, plaintiff's skeletal fixation products are purchased and used by hospitals, clinics, outpatient surgery centers, and doctors' offices. Plaintiff markets its products through its force of over six hundred salespeople, who not only sell the products but who also are present in the operating room during surgery, offering to the surgeons and the operating room staff their expertise in the proper use of the implants and instruments. (Schwartz Depo. at 23-24.) In the

hospital setting, plaintiff's salespeople meet with surgeons, with operating room staff, with central supply staff who clean and process the equipment, with purchasing department personnel, and with hospital administrative personnel. However, plaintiff's salespeople direct the vast majority (seventy-five percent) of their sales efforts to surgeons, because although the final decision to purchase the products is made by the hospital's administration or purchasing department, it is the surgeons who recommend the purchase and who exercise the greatest influence in the hospital's decision to purchase the products. (Schwartz Depo. at 97-100.)

Defendant's goods, as identified in the involved application and registration, are "disposable gloves for medical use."¹¹ Defendant argues that the gloves it actually sells are non-sterile and thus would not be used in a surgical environment. However, our likelihood of confusion determination must be made on the basis of the goods as identified in the application and registration, regardless of what the evidence shows to be the actual goods currently marketed by defendant. *See Canadian Imperial Bank*

¹¹ Plaintiff has submitted copies of other registrations owned by defendant which cover a variety of other goods for medical and hospital use, including sterile gauze bandages, crutches, walkers, canes, stethoscopes and surgical gowns and bonnets. However, because these other goods of defendant's are not marketed under defendant's SYNTHESIS marks, they are not relevant to our likelihood of confusion analysis in these proceedings.

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of Commerce v. Wells Fargo Bank, N.A., 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). Thus, the "disposable gloves for medical use" identified in defendant's application and registration must be deemed to include sterile surgical gloves. Such gloves are used by surgeons and operating room staff, the same persons who use plaintiff's bone surgery products.

Defendant sells its gloves to healthcare product distributors, who then sell the gloves to some of the same end purchasers who purchase plaintiff's products, i.e., to hospitals, outpatient surgery centers, and doctors' offices. (Sabatka Depo. at 31.) In doctors' offices, it is the doctor who makes the decision to purchase the gloves, while in larger settings such as hospitals the purchasing decision is made by the purchasing department. (Sabatka Depo. at 48.)

Comparing the parties' goods, trade channels and purchasers, we find that although applicant's gloves and plaintiff's bone surgery products are not competitive or interchangeable products, they nonetheless are sufficiently related in the marketplace that confusion is likely to occur if the products are sold under similar marks. There is an overlap in the end users of the respective products, i.e., both parties' products are used by operating room surgeons

and staff in the operating room environment, and by doctors and nurses in the outpatient center and doctor's office settings. We also find that the relevant class of purchasers for the respective goods is the same or overlapping. In the doctor's office setting, the decision to purchase both parties' products likely would be made by the doctor. However, it is likely that once the decision to purchase a particular vendor's products is made by the doctor, the actual ordering of the goods and maintenance of the office's inventory of such goods is done by clerical personnel, not by the doctor.

The same is true in the hospital setting. Initially, it is the surgeon who influences the hospital's decision to purchase plaintiff's bone surgery products, especially the more expensive complete sets of implants and instruments used for complicated procedures. However, once the initial decision to use plaintiff's products is made, the hospital must maintain an inventory of implants, instruments and accessories, in all necessary sizes. (Schwartz Depo. at 73-75.) Such routine and continuing purchases of plaintiff's products likely are authorized and made not by the surgeon directly, but by the hospital's purchasing office or other personnel in charge of maintaining the inventory, in collaboration with or at the request of the operating room department. The hospital's inventory of disposable surgical

gloves likewise would be maintained by the purchasing office, which would order the goods in collaboration with or at the request of the operating room department. Thus, plaintiff's products and defendant's products both are used by the operating room department of the hospital, and it is that department on whose behalf the hospital's purchasing department makes the actual purchases of the respective goods. The facts of this case therefore are distinguishable from those in the cases of *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992), and *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 USPQ 786 (1st Cir. 1983). In those cases, the respective goods of the parties were used by different departments in the hospital, and the decision to purchase the respective products was made or influenced by those different departments.

In short, we find that the parties' respective goods are related insofar as they are encountered and used by the same end users, i.e., by doctors and nurses in doctors' offices, and by surgeons and operating room staff in the hospital operating room environment. Doctor's office personnel and hospital operating room personnel are likely to encounter, in the doctor's office or in the operating room environment, both storage cases and trays containing plaintiff's products and bearing plaintiff's mark, and boxes

of disposable gloves bearing defendant's marks. We also find that the relevant purchasers of the goods overlap. In doctors' offices, these would be the doctors who make the decision to purchase the products and the clerical personnel who actually order the goods and maintain the inventory. In the hospital setting, the purchasers would be the surgeons in the operating room department, as well as the hospital's purchasing department which, in collaboration with or at the request of the operating room department, must maintain the proper level of inventory of the products.

On balance, we find that the parties' goods, and the trade channels and classes of purchasers for those goods, are sufficiently related that the second and third *du Pont* factors weigh in favor of a finding of likelihood of confusion.

Purchasing Conditions and Sophistication of Purchasers

Defendant's disposable medical gloves are inexpensive goods, retailing for four to seven dollars per box of one hundred, or four to seven cents per glove. (Sabatka Depo. at 30.) Plaintiff's products range in price from around ten dollars per unit for individual screws and plates to many thousands of dollars for complete sets of implants and instruments used in complicated surgical procedures. (See, e.g., Schwartz Depo., Exh. Nos. 5, 11.) Plaintiff directs

most of its marketing efforts to surgeons, who have a great amount of influence on the initial decision to purchase plaintiff's products. It is reasonable to assume that these surgeons are fairly sophisticated and knowledgeable about the sources of the bone surgery products they use and recommend for purchase, especially given the fact that plaintiff's salespeople deal with the surgeons directly in sales calls and in the operating room during surgery using the products.

As discussed above, however, it is likely that the responsibility for maintaining the proper level of inventory of plaintiff's implants and instruments falls not to the surgeon but rather to other operating room staff or hospital purchasing personnel, who may not have the benefit of the salesperson's personal attention when ordering the goods. These are the same persons who would be responsible for purchasing and maintaining the hospital's inventory of disposable medical gloves. We cannot assume that these hospital personnel are as sophisticated or knowledgeable as surgeons would be with respect to the sources of the goods or the trademarks under which they are sold. In any event, it is settled that even sophisticated purchasers are not immune to source confusion which would otherwise result from the use of confusingly similar marks. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221

USPQ 558 (TTAB 1983). We find that the fourth *du Pont* factor weighs in plaintiff's favor.

Fame of the Prior Mark

The fifth *du Pont* evidentiary factor requires us to consider evidence of the fame of plaintiff's mark, and to give great weight to such evidence if it exists. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, *supra*; and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the *DuPont* factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1897, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

Bose Corp. v. QSC Audio Products Inc., *supra*, 63 USPQ2d at 1305.

In this case, we find that plaintiff's SYNTHES mark indeed is a famous mark, for purposes of the fifth *du Pont* evidentiary factor. Plaintiff has used its mark in the

United States for decades. (Schwartz Depo. at 7-8.) It is true, as defendant argues, that plaintiff engages in no traditional advertising of its products. (*Id.* at 35, 80.) However, that does not mean that plaintiff engages in no marketing of its products. The dollar amount of plaintiff's marketing expenditures has been submitted under seal and will not be specified here, but we find without doubt that it is a quite impressive number. (Zaborowski Depo. at 7-8; Exh. No. 29.) Plaintiff actively markets its products to eighty percent of the hospitals in the United States. (Schwartz Depo. at 34.) Its salespeople are a common sight in the operating room environment. (*Id.* at 23-24.) Its catalogs and other literature, including procedure technique guides, are kept and used as references in hospital operating rooms around the country. (*Id.* at 21-22, 55-56.) Plaintiff sponsors an extensive program of continuing medical education activities (*id.* at 80-81), and it is a prominent presence at fifty trade shows and medical conventions per year, including all of the major shows and conventions in the industry. (*Id.* at 64-71; Exh. Nos. 24-25.)

As a result of these extensive marketing activities, plaintiff dominates the market in all aspects of the skeletal fixation field. (Schwartz Depo. at 59-60, 72-73.) In the April 2002 issue of Orthopedic Network News, a trade

journal, plaintiff was identified as the United States market leader in the sale of trauma products¹² in 2000-01, with a market share of over forty-five percent. (The next largest competitor was reported to have had a market share of fourteen percent.) Plaintiff's share of the market for bone surgery screws and plates is reported to have been over seventy-two percent. (Schwartz Depo. at 61-63, 71-73; Exh. No. 23.) Mr. Schwartz, plaintiff's Senior Vice-President, testified that under plaintiff's own estimates, plaintiff's current market share is even higher. (*Id.* at 59-61.) Plaintiff's sales figures for 1997-2001 have been submitted under seal and will not be specified here, but there can be no question that they are quite impressive. (Zaborowski Depo. at 7-8; Exh. No. 29.)

Based on this evidence, we find that plaintiff's SYNTHES mark and trade name are famous among the relevant purchasers at issue in this case. We find that the fifth *du Pont* factor weighs heavily in plaintiff's favor in our likelihood of confusion analysis.

Similar Marks in Use on Similar Goods

¹² "Trauma products" are identified in the report as consisting of plates and screws, hip fixation devices, external fixation, intramedullary nails, staples, pins and wires, maxillofacial devices, and instruments.

The sixth *du Pont* factor requires us to consider evidence of "similar marks in use on similar goods." There is no such evidence of record in this case. Defendant has submitted printouts, from the USPTO's database, of various pending applications and issued registrations covering marks which defendant contends are similar to those at issue in this case. We find, however, that the vast majority of these printouts cover marks and goods which are dissimilar to the marks and goods at issue here. Even as to the handful of printouts which arguably cover marks and goods similar to those at issue here, such printouts are not evidence that the marks depicted therein are in use in commerce or that purchasers are aware of them. They are entitled to no probative value under the sixth *du Pont* factor. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The sixth *du Pont* factor accordingly does not favor defendant in this case.

Actual Confusion (and the Opportunity for Actual Confusion)

The seventh *du Pont* factor requires us to consider evidence of "the nature and extent of any actual confusion." The eighth *du Pont* factor requires us to consider evidence pertaining to "the length of time during and conditions under which there has been concurrent use without evidence of actual confusion."

The evidence of record in this case shows that neither plaintiff or defendant is aware of any instances of actual confusion between their respective marks in the marketplace.

(Schwartz Depo. at 115-116; Sabatka Depo. at 57-59.)

Although this fact weighs in defendant's favor under the seventh *du Pont* factor, it is immediately counterbalanced and negated by the eighth *du Pont* factor, because we cannot conclude on this record that there has been any substantial opportunity for any actual confusion to have occurred. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). Although defendant's sales figures (which have been submitted under seal and shall not be detailed here) are not *de minimis*, neither are they so substantial as to warrant a presumption that the purchasers of plaintiff's goods necessarily have encountered defendant's goods in the marketplace (and that they thus have been in a position to be confused as to the source of the respective goods). Moreover, as defendant itself has noted, its gloves (as actually marketed) are not suitable for use in the operating room environment because they are non-sterile. This fact further diminishes the chances that both plaintiff's and defendant's actual goods have been encountered by the same actual purchasers in the marketplace.¹³

¹³ This fact (i.e., the unsuitability of defendant's non-sterile gloves for use in the operating room environment) is legally irrelevant when we are comparing the parties' goods under the

Because we cannot conclude (for purposes of the eighth *du Pont* factor) that there has been any significant opportunity for actual confusion to have occurred, we find that the absence of evidence of actual confusion (under the seventh *du Pont* factor) is neither factually surprising nor legally significant. See *Gillette Canada Inc. v. Ranir Corp. supra*. The seventh and eighth *du Pont* factors counterbalance each other, and they therefore are essentially neutral in this case.

Conclusion regarding Likelihood of Confusion

Having considered the evidence of record as it pertains to the relevant *du Pont* factors, and for the reasons discussed above, we conclude that a likelihood of confusion exists. In particular, given the fame and strength of plaintiff's mark and name, the overall similarity of defendant's marks thereto, and the overlapping trade channels and classes of purchasers (including purchasers of varying levels of sophistication), we conclude that the parties' respective goods (as identified in the respective

second *du Pont* factor, because our analysis under that factor must be based on the goods as identified in the application and registration, not on the goods as actually marketed by defendant. See discussion, *supra*. However, our analysis under the eighth *du Pont* factor requires us to consider the conditions under which the parties' goods actually have been marketed, i.e., the degree to which there has been any actual opportunity for confusion to have occurred.

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application and registrations) are sufficiently related that contemporaneous use of the parties' marks on such goods is likely to cause confusion as to source, sponsorship or other affiliation. To the extent that any doubt as to the correctness of this conclusion exists, it must be resolved in favor of plaintiff, the prior user, and against defendant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *Steelcase, Inc. v. Steelcare, Inc.*, 219 USPQ 433 (TTAB 1983); *Envirotech Corporation v. National Service Industries, Inc.*, 197 USPQ 292 (TTAB 1977).

CONCLUSION

Based on the evidence of record, and for the reasons discussed above, we find that plaintiff has established its standing to bring these opposition and cancellation proceedings, as well as its pleaded Section 2(d) ground for opposition and cancellation.

Decision: Opposition No. 91123720 is sustained, and registration of the mark in the involved application Serial No. 75909304 is refused. Cancellation No. 92031730 is granted, and the involved Registration No. 2371569 shall be cancelled in due course.

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